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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,547	03/22/2001	James E. Malackowski	73139/101	4464
26371	7590	11/30/2005		
FOLEY & LARDNER LLP 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308			EXAMINER KESACK, DANIEL	
			ART UNIT 3624	PAPER NUMBER

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,547

Applicant(s)

MALACKOWSKI ET AL.

Examiner

Dan Kesack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This application has been reviewed. Original claims 1-22 are pending.

The rejections are as stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Rules and regulations, such as the cited Section 501(c)(3) of the Internal Revenue Code can change over time, and it would be inappropriate as such, to have the scope of the claim change over time.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

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said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Martin, U.S. Patent No. 6,330,547 in view of Wilkinson, U.S. Patent Application Publication 2002/0099637.

Claim 1-3, 10, 17, 18, 20-22, Martin discloses a method of establishing intellectual property as a creditworthy collateral option in extending a line of credit, and for establishing a value for intellectual property assets used as collateral for loans made primarily to emerging companies. Martin uses a mathematical combination of factors surrounding the intellectual property involved, and uses this information to determine a liquidation value for specific intellectual property used as collateral for a loan (column 3, lines 8-10), in which case the security interest would use said collateral to recoup money lost in the investment. Martin teaches in the event that the applicant defaults on the loan, the lender is forced to repossess the IP collateral.

Martin fails to teach the security interest securing an ownership right to the intellectual asset upon failure by the venture to meet established parameters,

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and upon obtaining ownership, transferring the intellectual asset to a charitable organization.

Wilkinson discloses a process for investment in an intellectual property, providing valuation to the worth of the asset. Wilkinson suggests possible uses for the valuation of intellectual property, including as a bank loan using the IP as collateral, as a venture capital, and as a donation (paragraphs 20-23).

Therefore, it would have been obvious to one skilled in the art at the time of the Applicant's invention to donate said intellectual property after obtaining ownership, in order to recoup money lost in the failed investment.

Martin fails to teach the features of claims 4, 6, 8, 11-13, 15, 16, 19.

The features of claims 4, 6, 8, 11-13, 15, 16 and 19 are old and well-known practices in the art of financial lending. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teachings of Martin to include the steps of obtaining consent from the venture, and having the asset valued by a qualified appraiser, and determining the fair market value of an asset, and following all appropriate old and well known steps for securing the asset, and notifying appropriate parties about the security, and making a donation to a charitable organization.

Claim 5, Wilkinson fails to teach identifying a permissible donee to receive the intellectual asset.

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In order for the intellectual property to be donated, as addressed by Wilkinson above, an obvious first step would be to identify a donee. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teachings of Wilkinson to include the step of identifying a donee.

Claim 7, Martin fails to teach investing comprising of investing in an intellectual holding company if the intellectual holding company has ownership in the intellectual asset of the venture.

Martin teaches using an intellectual property asset as collateral for a loan or investment. This reference was modified by the teachings of Wilkinson, as described above, to be regarded as a method for investing in venture capital. It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify a loan given to an individual using the individual's intellectual property asset as collateral, to include an investment in an intellectual capital holding company, likewise using the holding company's intellectual asset as the collateral.

Claim 9, Martin and Wilkinson fail to teach donating the intellectual asset to a charitable organization.

Wilkinson teaches that the valuation of an intellectual property asset can be used for the purposes of venture capital, credit and collateral, and also for donation purposes (page 2, paragraph 40). Therefore, it would be obvious to

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one of ordinary skill in the art at the time of the Applicant's invention to donate the asset to a charitable organization.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HANI M. KAZIMI
PRIMARY EXAMINER